

Office Action Summary	Application No. 09/176,639	Applicant(s) SCHEDIWY ET AL.	
	Examiner SRILAKSHMI K. KUMAR	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 and 52-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 52-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The following office action is in response to the Pre Appeal Brief request. Claims 24, 52-96 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 24, 52-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 24 teaches the limitation of "said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object"... "wherein the conductivity of said touch layer is configured to limit the size of said [image] to approximately four time the area of contact of said conductive object".

Claim 52 teaches the limitation of "wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object".

Claim 63 teaches the limitation of "wherein the conductive touch layer comprises conductive carbon disposed in epoxy and has a conductivity selected to create an image of said

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conductive object that is at least four times larger than an area of contact of said conductive object”.

Claim 68 teaches the limitation of “wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object with said conductive touch layer”.

Claim 88 teaches the limitation of “wherein said conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object”.

With respect to claims 24, 52-96, the specification does not adequately disclose how the “conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object”. In the specification, on page 10, lines 4-7, applicant teaches “For best operation, the conductivity of the surface layer should be chosen such that the image of the stylus is about the same size as the image generated by a finger on a normal capacitive sensor.” However, the specification does not teach how the conductivity is chosen or selected as claimed in the independent claim. The specification on page 9, line 14-page 10, line 7, simply state that a conductivity that is too large or too small is flawed, however a moderate conductivity is appropriate. Therefore, the specification fails to accurately describe or define how a moderate conductivity is determined.

3. Claims 24, 52-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 24 teaches the limitation of “said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object”...”wherein the conductivity of said touch layer is configured to limit the size of said [image] to approximately four time the area of contact of said conductive object”.

Claim 52 teaches the limitation of “wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object”.

Claim 63 teaches the limitation of “wherein the conductive touch layer comprises conductive carbon disposed in epoxy and has a conductivity selected to create an image of said conductive object that is at least four times larger than an area of contact of said conductive object”.

Claim 68 teaches the limitation of “wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object with said conductive touch layer”.

Claim 88 teaches the limitation of “wherein said conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object”.

The specification does not adequately disclose how the “conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object”. In the specification on page 10, lines 4-7, applicant teaches “For best operation, the

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conductivity of the surface layer should be chosen such that the image of the stylus is about the same size as the image generated by a finger on a normal capacitive sensor.” However, the specification does not teach how the conductivity is chosen or selected as claimed in the independent claims without undue experimentation. The specification on page 9, lines 14-page 10, line 7, simply state that a conductivity that is too large or too small is flawed, however a moderate conductivity is appropriate. Further, the specification does not define how moderate conductivity is determined.

Therefore as stated in the MPEP, the specification does not meet the enablement requirement as it does not enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971). See MPEP 2161.01. Applicant is further directed to MPEP 2164.01 and 2164.06 (c) for further information in regards to undue experimentation.

Response to Arguments

1. Applicant's arguments with respect to claims 24, 52-96 have been considered but are moot in view of the new ground(s) of rejection.

Applicant is directed to the 35 USC 112, first paragraph rejection for written description, above, as the specification fails to comply with the written description requirement. The specification does not adequately disclose how the “conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object”. In the specification, on page 10, lines 4-7, applicant teaches “For best operation, the conductivity of the surface layer should be chosen such that the image of the stylus is about the same size as the

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image generated by a finger on a normal capacitive sensor." However, the specification does not teach how the conductivity is chosen or selected as claimed in the independent claim. The specification on page 9, line 14-page 10, line 7, simply state that a conductivity that is too large or too small is flawed, however a moderate conductivity is appropriate. The specification fails to accurately describe or define how a moderate conductivity is determined.

Similarly, the claims and specification fail to comply with the enablement requirement as it requires undue experimentation in order to determine conductivity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SRILAKSHMI K. KUMAR whose telephone number is (571)272-7769. The examiner can normally be reached on 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Lefkowitz can be reached on 571 272 3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Srilakshmi K Kumar/
Primary Examiner
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SKK
December 22, 2009